

REMARKS

Applicant respectfully requests reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

New claims 21-24 have been added.

This amendment adds, changes and/or deletes claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate defined status identifier.

After amending the claims as set forth above, claims 1-5, 8, 9, 11, 13, 14, 18, and 20-24 are now pending in this application.

Rejections under 35 U.S.C. § 103

Claims 1-5, 8, 11, 13, 14, 18, and 20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,392,248 (hereafter “Takahara et al.”) in view of U.S. Patent No. 6,429,430 (hereafter “Sato et al.”), U.S. Patent No. 5,545,899 (hereafter “Tran et al.”), and U.S. Patent No. 6,384,417 (hereafter “Okumura et al.”). This rejection is respectfully traversed.

Amended claim 1 recites a phosphor sheet for a radiation detector provided to be attached to a photoelectric conversion film of the radiation detector, comprising: a support having a sheet shape; and a phosphor layer which emits light in response to rays of radiation transmitted through a specimen, and including a layer coated on said support with powder of a rare earth oxysulfide phosphor activated by europium of concentration in a range of 0.01 mol% to 3.5 mol%, wherein said phosphor layer has a surface that is configured to be bonded onto the photoelectric conversion film by an adhesive that transmits light, wherein the photoelectric conversion film includes an amorphous silicon film or a single crystal silicon film, wherein the surface has a surface roughness of 0.5 μm or less in average roughness Ra. Claims 2-5 and 8 depend from claim 1.

Amended claim 11 recites a radiation detector, comprising: a phosphor sheet configured to convert radiation rays transmitted through a specimen into light, wherein the phosphor sheet comprises: a support having a sheet shape, and a phosphor layer including a layer coated on said support with powder of a rare earth oxysulfide phosphor activated by europium of concentration in a range of 0.01 mol% to 3.5 mol%; a photoelectric conversion film on which said phosphor sheet is layered, and which converts the light from said phosphor sheet into electric charges, wherein the photoelectric conversion film comprises an amorphous silicon film or a single crystal silicon film; and a charge information reading section having a plurality of pixels in contact with said photoelectric conversion film and reading out the electric charges generated on said photoelectric conversion film for each of the plurality of pixels as image signals of the radiation rays, wherein said phosphor layer has a surface bonded onto the photoelectric conversion film by an adhesive that transmits light, wherein the surface has a surface roughness of $0.5\ \mu\text{m}$ or less in average roughness Ra. Claims 13, 14, 18, and 20 depend from claim 11.

Takahara et al. discloses a color light emission sheet 4 that includes a flexible sheet base 6 and a phosphor layer 7 disposed on the sheet 6. See Takahara et al. at col. 7, line 63, to col. 8, line 2. Takahara et al. discloses that the color light emission sheet 4 can be made by mixing phosphor particles with a binder, adding a solvent to prepare a phosphor coating liquid, and coating the liquid onto the sheet base 6 and drying the liquid to form the phosphor layer 7. See Takahara et al. at col. 10, lines 33-41. However, Takahara et al. does not disclose or suggest that the phosphor layer 7 has a surface configured to be bonded onto a photoelectric conversion film by an adhesive that transmits light, as recited in claims 1 and 11.

Sato et al. discloses a scintillator panel 2 that includes a scintillator 12, a substrate 10, first transparent organic film 14, a transparent inorganic film 16, and a second transparent organic film 18. See Sato et al. at col. 3, lines 9-32. However, Sato et al. does not disclose or suggest that a phosphor layer having a surface configured to be bonded onto a photoelectric conversion film by an adhesive that transmits light, as recited in claims 1 and 11.

Tran et al. discloses a radiation detection panel 10 that includes a flat substrate 14, individual photosensitive modules 12, a phosphor layer 16, and a protective front plate 18. See Tran et al. at col. 4, lines 58-67. Tran et al. discloses that the phosphor may be coated on a separate sheet or glass substrate and then glued to the photosensitive modules 12. See Tran et al. at col. 5, lines 56-58. However, Tran et al. does not disclose or suggest that the glue is an adhesive that transmits light, as recited in claims 1 and 11.

Okumura et al. discloses a ceramic scintillator that is produced by sintering particles and heat treating the sintered body. See Okumura et al. at col. 2, lines 59-65; col. 3, lines 2-6; col. 4, lines 50-53; col. 7, lines 2-18. Okumura et al. discloses that the mean surface roughness of the sintered body is greater than or equal to 0.01 μm and smaller than or equal to 0.8 μm . However, Okumura et al. does not disclose or suggest does not disclose or suggest a phosphor layer having a surface configured to be bonded onto a photoelectric conversion film by an adhesive that transmits light, as recited in claims 1 and 11.

It would not have been obvious to one of ordinary skill in the art to combine the teachings of Takahara et al., Sato et al., Tran et al., and Okumura et al. to provide the phosphor sheet of claim 1 and the radiation detector of claim 11. Two basic requirements of a *prima facie* case of obviousness are (1) that there is some suggestion to combine references and (2) that prior art references, when properly combined, must teach or suggest all of the claim limitations. See M.P.E.P. §§ 2143, 2143.03. The combination of Takahara et al., Sato et al., Tran et al., and Okumura et al. is neither suggested nor does it disclose or suggest all of the features recited in claims 1 and 11 because these references do not disclose a phosphor layer having a surface configured to be bonded onto a photoelectric conversion film by an adhesive that transmits light. Therefore, it would not have been obvious to combine these references to provide the phosphor sheet of claim 1 and the radiation detector of claim 11.

Applicant hereby reiterates and incorporates in their entirety the remarks filed on September 11, 2007, which were filed in response to the Office Action dated June 11, 2007. Applicant respectfully submits that claims 1-5, 8, 11, 13, 14, 18, and 20 are allowable for at least the reasons described in those remarks, which explain why there is no suggestion to a person skilled in the art to combine the applied references. Furthermore, the PTO, in the

Advisory Action, cursorily and completely improperly dismisses those arguments, with the misplaced citation of *Ex parte Obiaya*, which relates to an attempt to rebut a *prima facie* case of obviousness, once properly made, by relying on a new, allegedly surprising property in a situation where “appellant has recognized another advantage which **would flow naturally from following the suggestion of the prior art.**” (227 U.S.P.Q. at 60, emphasis added) Applicant submits that it is not simply arguing non-obviousness because of the discovery of a new property for an article that has been shown to be *prima facie* obvious as following “the suggestion of the prior art”, which *Ex parte Obiaya* regards, but instead that the claimed invention would not have been *prima facie* obvious, in the first place, to one of ordinary skill in the art because there is no proper suggestion to combine the teachings of Takahara et al., Sato et al., Tran et al., and Okumura et al., which are essentially non-analogous with one another due to their differences in structure and due to their different purposes and uses. *See* 227 U.S.P.Q. 58, 60 (Bd. Pat. App. & Inter. 1985) (copy attached).

For at least the reasons discussed above, withdrawal of this rejection is respectfully requested.

Claim 9

Claim 9 is rejected under 35 U.S.C. § 103(a) as being unpatentable Takahara et al., Sato et al., Tran et al., and Okumura et al. as applied to claim 1 above, and further in view of U.S. Patent No. 6,394,650 (hereafter “Ohara et al.”). This rejection is respectfully traversed. Ohara et al. fails to remedy the deficiencies of Takahara et al., Sato et al., Tran et al., and Okumura et al. discussed above in regard to independent claim 1, from which claim 9 depends. Withdrawal of this rejection is respectfully requested.

New Claims

New claims 21-24 have been added. Claims 21 and 22 depend from claim 1 and claims 23 and 24 depend from claim 11. Applicant respectfully submits that claims 21-24 are allowable over the prior art for at least the reasons discussed above.

Claims 21 and 23 further recite “wherein the phosphor layer is a slurry coated layer coated on the support from a slurry that includes the powder of the rare earth oxysulfide phosphor activated by europium.” Okumura et al. discloses a ceramic scintillator that is produced by sintering particles and heat treating the sintered body. See Okumura et al. at col. 2, lines 59-65; col. 3, lines 2-6; col. 4, lines 50-53; col. 7, lines 2-18. The Office argues that it would have been obvious to combine the teachings of Takahara et al., Sato et al., Tran et al., and Okumura et al. to provide the phosphor sheet of claim 1 and the radiation detector of claim 11. See Final Office Action dated June 11, 2007 at page 7. However, such a combination would result in a phosphor layer that is sintered, as taught by Okumura et al., not a phosphor layer that “is a slurry coated layer coated on the support from a slurry that includes the powder of the rare earth oxysulfide phosphor activated by europium.” The combination of Takahara et al., Sato et al., Tran et al., and Okumura et al. does not disclose or suggest the features of claims 21 and 23.

Applicants submit that the language “a slurry coated layer” recites structure rather than process limitations. In particular, this language regards the structure of a slurry coated layer, not the step of coating a slurry to form a layer. In *Hazani v. ITC*, 126 F.3d 1473, 1479 (Fed. Cir. 1997) the Federal Circuit addressed the limitation “chemically engraved” and found that “those claims are best characterized as pure product claims, since the ‘chemically engraved’ limitation, read in context, describes the product more by its structure than by the process used to obtain it.” A copy of this case is provided with this response.

Therefore, Applicant respectfully submits that claims 21 and 23 recite structure that is not disclosed or suggested by the prior art. The phosphor layer of the invention and the ceramic scintillator of Okumura et al. have different structures that result from the completely different ways in which they are made. The phosphor layer of the present invention includes the phosphor powder coated layer, so that the surface having surface roughness Ra of 0.5 μm or less is obtained by performing a smoothing treatment for the surface of the phosphor layer by using a metal roll or a metal plate. See paragraph 0068 of the specification. In contrast, the ceramic scintillator of Okumura et al. includes the sintered body, so that the surface having surface roughness Ra in the range of 0.01 to 0.8 μm is obtained by etching or polishing the surface of the sintered body. See Okumura et al. at column 6, lines 23-38.

Furthermore, the phosphor layer of the present invention and the ceramic scintillator of Okumura et al. have surface roughness properties for different purposes. The phosphor layer in the present invention has surface roughness Ra of 0.5 μm or less to improve the definition and resolution of the radiation image. In contrast, the ceramic scintillator of Okumura et al. has a surface roughness Ra in the range of 0.01 to 0.8 μm to improve luminous intensity, but not to improve the definition and resolution. Thus, the reason for having and the principle of operation of the surface roughness Ra of the phosphor layer in the present invention differ completely from those of the ceramic scintillator of Okumura et al.

Applicant submits that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check or credit card payment form being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

Date 11/13/2007

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[2] Finally, as witness the fact that applicant has filed an intent to use application, the well established rule that doubts are to be resolved against a newcomer and in favor of an established longtime user applies here. *San Fernando Electric Mfg. Co. v. JFD Electronics Components Corp.*, 565 F.2d 683, 196 USPQ 1 (CCPA 1977) (dismissal of opposition to registration of MICRO CERAM by owner of MONOCERAM applied to identical goods reversed). As stated in that case, in addition to the "newcomer rule" and equally applicable here, is the principle that notwithstanding the fact that each syllable of each mark generates its own impact, the only impact to be considered is that of the marks as a whole; they are not to be dissected in considering likelihood of confusion or mistake. *Id.*, 565 F.2d at 685, 196 USPQ at 3.

CONCLUSION

The Board's dismissal of the opposition is reversed.

REVERSED

RADER, Circuit Judge, dissents.



Emanuel HAZANI and Patent
Enforcement Fund, Inc.,
Appellants,

v.

UNITED STATES INTERNATIONAL
TRADE COMMISSION,
Appellee,
and

Mitsubishi Electric Corporation
and Mitsubishi Electronics
America, Inc.,
and

NEC Corporation and NEC
Electronics, Inc.,
and

OKI Electric Industry Co., LTD.
and OKI America, Inc.,
and

Samsung Electronics Co., LTD., Samsung
Electronics America, Inc., and Samsung
Semiconductor, Inc., Intervenor.

Nos. 96-1231, 96-1262, 96-
1411 and 96-1415.

United States Court of Appeals,
Federal Circuit.

Oct. 14, 1997.

Patentee brought complaint alleging that importers of electronic products engaged in unfair import trade practices by importing and selling goods that infringed patent relating to semiconductor memory cells. The International Trade Commission denied relief, and patentee appealed. The Court of Appeals, Bryson, Circuit Judge, held that: (1) arguments raised for first time on motion for reconsideration were untimely; (2) patent did not require capacitor capable of storing charge in all modes of operation; (3) patent claims were anticipated by prior art; and (4) single unanticipated claim was not infringed by accused products.

Affirmed.

1. Federal Courts ⇐776

Whether summary determination is proper is question of law, and Court of Appeals reviews summary determinations de novo. 19 C.F.R. § 210.18(b).

2. Customs Duties ⇨84(6)

Where administrative law judge had not made any factual determinations in administrative proceedings upon complaint charging importers with unfair practices, substantial evidence standard of review was not applicable.

3. Customs Duties ⇨84(6)

Arguments raised by patentee for first time on motion for reconsideration, in International Trade Commission proceedings in which patentee complained of importers' alleged unfair practices, were untimely.

4. Patents ⇨67.1

To anticipate patent claim, prior art reference must disclose every feature of claimed invention, either explicitly or inherently.

5. Patents ⇨323.2(4)

Whether patent claim feature is inherent in prior art reference is factual issue on which extrinsic evidence may be submitted, and, for summary determination to be proper, there must be no genuine dispute whether limitations of claimed invention are disclosed, either explicitly or inherently, by allegedly anticipating prior art reference.

6. Patents ⇨101(2)

Patent for semiconductor memory cell which recited capacitor and specified structural characteristics of that capacitor did not require that capacitor be capable of storing charge in all modes of operation, as claim defined "capacitor" in structural terms not by reference to function that had to be performed under all circumstances, and patent's phrase "in all modes of operation of the memory cell" referred to separate characteristic.

7. Patents ⇨66(1.14)

Patent for semiconductor memory cell was anticipated by prior art patent which sufficiently disclosed each and every feature recited in patent. 35 U.S.C.A. § 102(e).

8. Customs Duties ⇨84(7)

Patentee could not rely on evidence that was not timely presented to administrative

law judge, on patentee's appeal from International Trade Commission's denial of relief upon patentee's complaint alleging that importers engaged in unfair practices.

9. Patents ⇨101(2)

Patent claims for semiconductor memory cell which recited plate with chemically engraved surface were not product-by-process claims, but were pure product claims, since "chemically engraved" limitation, read in context, described product more by its structure than by process used to obtain it; thus, such claims were anticipated by same prior art reference that anticipated patent's claims which recited plate with "textured" surface.

10. Patents ⇨236(2)

Semiconductor memory cell patent claim describing third conductive connecting means as "bit line of said array that is integrally formed in said substrate" required bit line that was entirely formed within substrate, rather than bit line that was partially formed within substrate, and thus was not infringed by accused products.

Marcus J. Millett, Lerner, David, Littenberg, Krumholz & Mentlik, Westfield, NJ, for appellants. With him on brief was Charles P. Kennedy. Co-Counsel for Patent Enforcement Fund, Inc. was Theodore I. Botter, Fair Lawn, NJ.

Mark D. Kelly, Attorney, United States International Trade Commission, for appellee. With him on brief were Lyn M. Schlitt, General Counsel, and James A. Toupin, Deputy General Counsel.

Robert M. Taylor, Jr., Lyon & Lyon, Costa Mesa, CA, submitted on brief for Intervenor Mitsubishi Electric Corporation and Mitsubishi Electronics America, Inc. With him on brief was David B. Murphy. Of counsel was Kevin M. O'Brien, Baker & McKenzie, Washington, DC.

J. Frank Osha, Sughrue, Mion, Zinn, Macpeak & Seas, Washington, DC, submitted on brief for Intervenor NEC Corporation and NEC Electronics Inc. With him on brief were Joseph Bach, Howard L. Bernstein, Alan J. Kasper and Kevin A. Wolff. Of counsel were Italo H. Ablondi, David Foster

and Sturgis M. Sobin, Ablondi, Foster, Sobin & Davidow, Washington, DC.

Jared B. Bobrow, Weil, Gotshal & Manges, LLP, Menlo Park, CA, argued for Intervenor OKI Electric Industry Co., LTD and OKI America, Inc. With him on brief were Matthew D. Powers and Paul M. Saraceni.

Cecilia H. Gonzalez, Howrey & Simon, Washington, DC, argued for Intervenor Samsung Electronics Co., LTD, Samsung Electronics America, Inc. and Samsung Semiconductor, Inc. With her on brief were Thomas J. Scott, Jr. and Juliana M. Cofrancesco.

Before PLAGER, SCHALL, and BRYSON, Circuit Judges.

BRYSON, Circuit Judge.

This case involves semiconductor memory cells. Appellants Emanuel Hazani and Patent Enforcement Fund, Inc. (collectively Hazani), petitioned for relief in the United States International Trade Commission (ITC) against a number of importers of electronic products. Hazani contended that the importers were engaged in unfair import trade practices, in violation of 19 U.S.C. § 1337, because their importation and sale of imported goods in the United States infringed Hazani's rights under a U.S. patent relating to semiconductor memory cells. The ITC denied relief on the ground that the asserted claims of Hazani's patent were either invalid or not infringed by the respondents. We affirm.

I

A

Semiconductor memories generally consist of a number of individual memory cells. One type of semiconductor memory is an electrically erasable programmable read-only memory (EEPROM). EEPROMs are non-volatile memories; that is, the data stored in the memory cells of an EEPROM is not lost when the power to the memory device is turned off.

An EEPROM cell includes a field-effect transistor (FET), which has a control gate, and source and drain regions formed in a substrate. In an FET, the control gate is formed above a dielectric insulator that is

deposited over the area between the source and drain regions. As voltage is applied to the control gate, mobile charged particles in the substrate form a conduction channel in the region between the source and drain regions. Once the channel forms, the transistor turns "on" and current may flow between the source and drain regions.

An EEPROM may be formed by adding a "floating gate," a conductive plate located in the dielectric insulator between the control gate and the channel region. The control gate, dielectric insulator, and floating gate form a capacitor that is capable of storing charge on the floating gate. If the floating gate is storing charge of an appropriate polarity, the FET of the EEPROM cannot turn on, thus indicating one memory state. When the floating gate is not storing any charge, the FET may operate as it does in the absence of the floating gate, which indicates the other memory state.

B

Hazani owns U.S. Patent No. 5,166,904 (the '904 patent) entitled "EEPROM Cell Structure And Architecture With Increased Capacitance and With Programming and Erase Terminals Shared Between Several Cells." The claims of the '904 patent are not explicitly limited to EEPROM semiconductor memory cells, but generally relate to a semiconductor memory cell having features found in EEPROM cells.

Hazani filed a complaint with the ITC alleging that certain dynamic random access memory devices (DRAMs) imported by suppliers of electronic components infringe various claims of the '904 patent. In early 1995, the ITC began an investigation of Hazani's complaint, naming the importers and their American distributors as respondents.

The administrative law judge to whom the case was assigned ruled in favor of the respondents, issuing three summary dispositions, the last of which terminated the investigation. The administrative law judge ruled that all of the asserted claims except claim 14 were anticipated under 35 U.S.C. § 102(e) by U.S. Patent No. 4,758,986 to Kuo. Claim 14, the administrative law judge ruled, was not

infringed by any of the accused products. The ITC declined to review the summary determination orders and the order terminating the investigation.

II

[1, 2] On appeal, Hazani challenges all three summary determinations. The question whether a summary determination is proper is a question of law. See 19 C.F.R. § 210.18(b) (summary determination is proper "if the evidence of record show[s] that there is no genuine issue as to any material fact and that the moving party is entitled to summary determination as a matter of law"). We review summary determinations *de novo*. See *Intellicall, Inc. v. Phonometrics, Inc.*, 952 F.2d 1384, 1387, 21 USPQ2d 1383, 1386 (Fed.Cir.1992). Because the administrative law judge has not made any factual determinations at this stage in the proceedings, the substantial evidence standard of review is not applicable. Contrary to the ITC's suggestion, *LaBounty Manufacturing, Inc. v. United States International Trade Commission*, 867 F.2d 1572, 9 USPQ2d 1995 (Fed.Cir. 1989), does not hold otherwise.

A

Hazani first challenges the determination that claims 1-2, 4-13, 15-17, 22, and 25 are anticipated by Kuo. Claim 1 is representative; it recites:

1. A semiconductor memory cell including a capacitor that is coupled to a field effect transistor (FET), said memory cell and said capacitor and said transistor are formed on a semiconductor substrate and wherein said capacitor is insulated from the control gate of said transistor, and said capacitor comprising:

an electrically conductive polysilicon first plate having a surface that was textured to have a predetermined pattern;

a first insulator constituting an oxide dielectric layer being disposed over and in contact with said textured surface of said polysilicon first plate;

a second insulator having at least one dielectric layer with a higher dielectric constant than the dielectric constant of said oxide layer, said second insulator being disposed along and in contact with said first insulator so that said first insulator is

disposed between said first plate and said second insulator;

a second plate of an electrically conductive material being disposed along and in contact with said second insulator to form a sandwich wherein said dielectric layers are disposed between said plates, thereby said capacitor exhibiting increased capacitance and said capacitor exhibiting reduced charge transport capability between said plates so that it is lower than the charge transport capability characteristically exhibited by said first insulator alone in all modes of operation of said memory cell.

Hazani raises two main challenges to the anticipation ruling. First, Hazani argues that claim 1 requires a structure that stores charge in all modes of operation, and that the Kuo patent does not disclose such a structure. Second, Hazani argues that Kuo's structure does not inherently satisfy the "increased capacitance" and "reduced charge transport" limitations in the "thereby" clause of claim 1.

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[3] The ITC and the respondents contend that the arguments Hazani presses upon us were not timely raised before the administrative law judge and therefore should be deemed waived. Before the initial determination, Hazani argued only that Kuo did not disclose a capacitor or "make[] any explicit reference to an 'increased capacitance' or to a 'reduced charge transport capability.'" Only on reconsideration did Hazani argue (1) that Kuo does not disclose a structure inherently satisfying the limitations of the "thereby" clause of claim 1, and (2) that the claims of the '904 patent require a structure that stores charge in all modes of operation.

The administrative law judge denied Hazani's motion for reconsideration, holding that Hazani's new arguments should have been raised prior to the original ruling. In the alternative, the administrative law judge concluded that in any event the new arguments would not change the outcome of the case. The ITC declined to review the administrative law judge's summary determination.

We find no legal error in the administrative law judge's determination that the argu-

ments that Hazani raised for the first time on reconsideration were untimely and could properly be rejected on that ground alone. Like the administrative judge, however, we have examined those arguments and have concluded that even if they had been timely raised, they would not have led to a different result.

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[4, 5] To anticipate a claim, a prior art reference must disclose every feature of the claimed invention, either explicitly or inherently. See *Glaxo Inc. v. Novopharm Ltd.*, 52 F.3d 1043, 1047, 34 USPQ2d 1565, 1567 (Fed. Cir.1995). Whether a claim feature is inherent in a prior art reference is a factual issue on which extrinsic evidence may be submitted. See *Continental Can Co. USA v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed.Cir.1991). For summary determination to be proper, there must be no genuine dispute whether the limitations of the claimed invention are disclosed, either explicitly or inherently, by an allegedly anticipating prior art reference. See *Avia Group Int'l, Inc. v. L.A. Gear Cal., Inc.*, 853 F.2d 1557, 1561-62, 7 USPQ2d 1548, 1552 (Fed. Cir.1988).

[6] Hazani argues that a capacitor within the meaning of the '904 patent must be capable of storing charge in all modes of operation and that the purported capacitor in Kuo does not have that property. The pertinent portion of Kuo discloses a structure having two conductive plates separated by a dielectric insulator, which is the structure of a capacitor. During the erase mode of Kuo's memory cell, that structure exhibits tunneling, i.e., it allows current to pass between the two plates. Because tunneling is by definition inconsistent with the storage of charge, Hazani argues that Kuo's structure stores charge only in certain modes of operation and therefore cannot be considered a "capacitor," as that term is used in the '904 patent.

Contrary to Hazani's argument, claim 1 of the '904 patent does not require a structure that stores charge in all modes of operation. Instead, the claim recites a capacitor and specifies the structural characteristics of that capacitor. The particular capacitor recited in the claim is defined as having two insulators between two conductive plates, one of the

insulators having a higher dielectric constant than the other. Thus, the claim defines the term "capacitor" in structural terms; it does not define the term by reference to a function that must be performed under all circumstances. While a capacitor is commonly defined as a device that is capable of storing charge, see, e.g., Richard C. Dorf, *Electrical Engineering Handbook* 30 (1993), a device that performs that function may still be referred to as a capacitor even if, under certain circumstances, it does not store charge but exhibits some other property such as tunneling.

Pointing to the "thereby" clause of the claim, Hazani argues that the phrase "in all modes of operation of the memory cell" in that clause supports its argument that the capacitor recited in the '904 patent must store charge in "all modes of operation." That argument, however, is based on a contorted reading of the claim language. The phrase "in all modes of operation of the memory cell" refers to a comparison of the claimed two-insulator capacitor and a similar capacitor with a single insulator; it does not suggest that a device is not a capacitor, within the meaning of the claim, if it does not store charge in all modes of operation. The "in all modes of operation" phrase immediately follows and specifically refers to the requirement that the claimed two-insulator structure exhibit charge transport capability that is "lower than the charge transport capability characteristically exhibited by said first insulator alone." It is thus the reduced charge transport capability compared to a one-insulator structure that the capacitor must exhibit "in all modes of operation."

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[7] Under this interpretation, it is clear that Kuo discloses each and every feature recited in claim 1 of the '904 patent. Hazani does not dispute that Kuo's structure stores charge under certain operating conditions. Nor is there any ground for dispute that Kuo's structure exhibits reduced charge transport, compared to a one-insulator device, in all modes of its operation. Additionally, Kuo specifically discloses the use of a "multi-layer" insulator between the two

plates, which can consist of an oxide-nitride-oxide (ONO) layered dielectric insulator. Although Hazani argues that Kuo does not disclose that the layers of oxide, nitride, and oxide are uniform between the two plates, the claims do not so require. For that reason, disclosure of an ONO insulator between the plates is sufficient.

The evidence before the administrative law judge established that the first insulator in Kuo, an oxide, has a lower dielectric constant than the second insulator, a nitride, and that such a structure exhibits lower charge transport capability in all modes of operation than a similar device with a single oxide insulator. In particular, the respondents submitted a declaration by an expert, Dr. Caywood, who stated that a capacitor with an ONO insulator structure, as disclosed in Kuo, would necessarily exhibit increased capacitance and reduced charge transport capability as compared to a capacitor with an oxide insulator alone. Dr. Caywood stated that Kuo disclosed the same physical structure as recited in the claims of the '904 patent and therefore Kuo's structure would necessarily exhibit the same properties. In addition, one of Hazani's own experts, Mr. Greene, responded affirmatively when asked whether the ONO insulator structure of Kuo would inherently yield reduced charge transport capability compared to the charge transport capability of an oxide-only insulator.

Hazani argues that the administrative judge improperly characterized Mr. Greene's testimony as an admission that the structure disclosed by Kuo would inherently result in increased capacitance and reduced charge transport capability compared to an otherwise similar structure with a single oxide insulator. Dr. Caywood's declaration alone, however, is sufficient to support the administrative law judge's summary determination. Even if Mr. Greene's testimony should not be interpreted in a manner that supports the administrative law judge's determination, that testimony does not create a factual dispute because it does not contradict Dr. Caywood's statements on the issue of the respective charge transport capability of the two insulator structures in question.

While the motion for summary determination was pending, Hazani did not submit any evidence in response to the evidence relied

on by the respondents. Only on reconsideration did Hazani argue that the characteristics recited in the thereby clause of claim 1 were not inherent in the Kuo structure. At that late stage, after the administrative law judge had already granted the respondents' motion for summary determination, Hazani submitted testimony from another of its experts, Dr. Oldham, in an effort to create a factual dispute as to whether the Kuo structure inherently possessed reduced charge transport capability compared to a one-insulator device.

[8] Dr. Oldham's testimony was not presented to the administrative law judge in a timely matter. At the summary determination stage, Hazani was put on notice that the respondents were contending that many of the limitations of the claims were inherent in Kuo's disclosure. While we have considered arguments that Hazani did not raise in response to the summary determination motion, we find no reason to allow Hazani to rely on evidence that was not timely presented to the administrative law judge. Accordingly, we will not consider Hazani's argument to the extent that it relies on Dr. Oldham's deposition testimony. Based on the evidence that was before him at the time he ruled on the summary determination motion, the administrative law judge properly concluded that there was no genuine issue of material fact as to whether the two-insulator device disclosed in Kuo exhibited reduced charge transport when compared to a similar device with a single-oxide insulator.

4

Hazani makes the further argument that Kuo's structure does not anticipate claim 1 because the combination of surface asperities and an ONO insulator would not necessarily result in increased capacitance or reduced charge transport capability. Hazani relies on U.S. Patent No. 4,750,360 to Faraone, a declaration by Faraone, deposition testimony by Dr. Caywood, and deposition testimony by another expert, Dr. Gosney, to argue that one of ordinary skill in the art would use a thick ONO insulator when introducing asperities on one of the plates of the capacitor. A thicker insulator would result in reduced capacitance and increased charge transport ca-

pability, rather than the contrary. Again, however, none of that evidence was presented to the administrative law judge before his initial determination. We therefore decline to consider that evidence in light of its untimely presentation to the administrative law judge.

In support of his contention that all of the evidence submitted to the administrative law judge, even the untimely evidence, should be considered on appeal, Hazani argues that the untimely evidence was considered and addressed by the administrative law judge on reconsideration and that the ITC therefore necessarily must have considered that evidence as a basis for its decision not to review the administrative law judge's decision. We disagree. The administrative law judge found that all of the newly submitted arguments and evidence were untimely, and addressed the merits of the untimely arguments and evidence only in the alternative. The ITC's decision not to review the administrative law judge's determination therefore cannot be said to be based on consideration of the untimely evidence. For that reason, the Commission's decision can be upheld on the ground, invoked by the administrative law judge, that much of the evidence on which Hazani now relies was not properly presented.

B

[9] Hazani also challenges the ITC's final determination that claims 18-20 and 26-28 are anticipated by Kuo. Claim 18 is representative. The only relevant difference between claim 18 and claim 1 is that claim 1 recites that the first plate has a "textured" surface, whereas claim 18 recites that the first plate has a "chemically engraved" surface. Because Hazani did not present any evidence that the product described in Kuo and the product recited in claim 18 are different, the administrative law judge determined that the "chemically engraved" limitation was irrelevant to patentability. Accordingly, the administrative law judge held claims 18-20 and 26-28 invalid as anticipated by Kuo.

Hazani argues that the "chemically engraved" claims are product-by-process claims. We agree with the respondents, however, that those claims are best characterized as pure product claims, since the

"chemically engraved" limitation, read in context, describes the product more by its structure than by the process used to obtain it. See *In re Moore*, 439 F.2d 1232, 1236, 58 C.C.P.A. 1042, 169 USPQ 236, 239 (1971); *In re Garnero*, 412 F.2d 276, 278-79, 56 C.C.P.A. 1289, 162 USPQ 221, 223 (1969). As such, the claims are anticipated, because the claimed products are found in the prior art.

The specification of the '904 patent describes the "chemically engraved" surfaces as "textured with asperities" as a result of oxidation. See '904 patent, col. 7, lines 47-51 ("the floating gate 30's surface is oxidized ... such that mainly the top surface of layer 30 ... is textured with asperities"). Kuo similarly discloses a conductive plate and states that a surface of the conductive plate adjoining the insulator may be textured with asperities. See Kuo, col. 4, lines 41-43 ("Asperities, or roughness, of the polysilicon-dielectric interfaces are relied upon to decrease the erase voltages to reasonable levels."). In addition, the respondents submitted an affidavit from Dr. Caywood attesting to the fact that one of ordinary skill in the art would conclude that the asperities associated with oxidation are the same as those disclosed in Kuo.

Based on the record before him, the administrative law judge was justified in concluding that the chemically engraved products disclosed in the '904 patent, *i.e.*, surfaces that have asperities of the sort produced by oxidation, are identical for all relevant purposes to the product described by Kuo. The administrative law judge therefore correctly concluded held that the "chemically engraved" claims in the '904 patent fail to define a novel product and are thus invalid.

C

[10] Hazani next challenges the summary determination that certain products imported by the respondents do not infringe claim 14. The claim language in dispute states: "said third conductive connecting means is a bit line of said array that is integrally formed in said substrate; and wherein said bit line comprising [sic] impurities." The administrative law judge determined that the claims

require a bit line that is entirely formed within the substrate. Hazani, on the other hand, argues that the bit line need only be partially formed within the substrate.

We agree with the administrative law judge's interpretation. The claims require that the bit line be "integrally formed in" the substrate, which we interpret to mean that the entire bit line must be located within the substrate. Although the term "integrally formed in" is not defined in the written description portion of the specification, the word "integral" means "complete" or "entire," and the word "in," as used in this context, means "indicating a point or place thought of as spatially surrounded or bounded." See *Webster's New International Dictionary* 1253, 1290 (2d ed.1939).

Hazani has not given us any reason to depart from the ordinary meaning of those words. Accordingly, the term "integrally formed in," as used in claim 14, requires that the bit line be formed entirely within the substrate. Under that interpretation of claim 14, the accused products do not infringe. We therefore uphold the ITC's ruling on the issue of infringement as well as on the invalidity issues.

AFFIRMED.



Ramon J. MARTINEZ, Petitioner,

v.

**MERIT SYSTEMS PROTECTION
BOARD, Respondent.**

No. 96-3354.

United States Court of Appeals,
Federal Circuit.

Oct. 15, 1997.

Customs Service employee petitioned for review of final decision of Merit Systems Protection Board, 71 MSPR 262, that dismissed, for lack of jurisdiction, employee's appeal of his loss of availability pay after his reassignment. The Court of Appeals, Schall, Circuit Judge, held that employee's involuntary reassignment from criminal investigator

position to physical security specialist position and his consequent loss of availability pay did not trigger the Board's jurisdiction over involuntary reductions in pay.

Affirmed.

1. Officers and Public Employees ⇐11.8

Merit Systems Protections Board's jurisdiction is not plenary; rather, it is limited to actions appealable to it under any law, rule, or regulation. 5 U.S.C.A. § 7701(a).

2. Officers and Public Employees ⇐11.8

Aggrieved employee had burden of establishing Merit Systems Protections Board's jurisdiction. 5 U.S.C.A. § 7701(a); 5 C.F.R. § 1201.56(a)(2).

3. Officers and Public Employees ⇐11.8

Question of Merit Systems Protections Board's jurisdiction presents issue of statutory interpretation which court of appeals reviews de novo. 5 U.S.C.A. § 7701(a).

4. Customs Duties ⇐60

Customs Service criminal investigator's availability pay, for certain hours worked in excess of regular work day, was premium pay, rather than basic pay, and thus involuntary reassignment from criminal investigator position to physical security specialist position and consequent loss of availability pay, did not trigger Merit Systems Protection Board's jurisdiction over involuntary reductions in pay. 5 U.S.C.A. §§ 5545a(h)(1), 7511(a)(1, 4), 7512(4).

Lawrence A. Berger, Mahon & Berger, Garden City, New York, argued for petitioner.

Joyce G. Friedman, Attorney, Office of the General Counsel, Merit Systems Protection Board, Washington, D.C., argued for respondent. With her on the brief were Mary L. Jennings, General Counsel, and Martha B. Schneider, Assistant General Counsel.

Before MAYER, RADER, and SCHALL, Circuit Judges.

of the majority, nowhere found in the complaint. In the second cause of action, after identifying the parties, plaintiff alleges that she sold to defendant the right to produce her design solely on fabric and defendant without authorization thereafter licensed Sunweave Linen Corp. and Lord & Taylor to reproduce the design on products other than fabric "in direct contravention of the terms of the agreement between plaintiff and defendant." Plaintiff concludes: "Defendant required Sunweave and Lord & Taylor, to place on certain of the unauthorized products sold by Sunweave and Lord & Taylor, containing the Design, a credit for the Design stating it was 'designed by Waverly', even though in truth and in fact defendant knew that such pattern was designed by the plaintiff, to the damage of the plaintiff in the sum of \$25,000." It is undisputed that the contract referred to by plaintiff was never reduced to writing.

The oral contract is thus plainly at the heart of the second cause of action. Plaintiff contends that she sold a limited right, permitting defendant to use the design solely on fabric and wallpaper, while defendant claims that it purchased all of plaintiff's right, title and interest in the design, and consequently that its use was unrestricted. If plaintiff sold a limited right only — her version of the contract — defendant breached the contract and thereby misappropriated the design and misrepresented ownership. If plaintiff sold defendant all rights in the design — defendant's version of the contract — then it could lawfully place its own name on and market its property, without further permission from plaintiff.

Even if the second cause of action were not preempted by federal law, still there would be no enforceable claim because of the Statute of Frauds. The very design of the Statute of Frauds was "not to trust the memory of witnesses for a longer time than one year." (*Smith v. Westfall*, 1 Lord Raymond 316, 317 [1697], quoted in *D & N Boening v Kirsch Beverages*, 63 NY2d 449, 454.) The requirement of a writing assures that there will be reliable evidence of the terms of a contract, an objective which is defeated and circumvented by permitting plaintiff, in a dispute over the terms of a contract, to enforce what is merely one version of the contract in the guise of a tort.

A reading of the second cause of action as pleaded in the complaint reveals that it is not, as the majority describes, premised on "unfair competition" (slip opn, p 4), but — to use plaintiff's own words — on "direct contravention of the terms of the agreement between plaintiff and defendant." (Complaint, ¶7.) In contracts for the sale of products, any purchaser exercising dominion over the products, including placing its name on what it believes it

rightly owns, can be said by a seller charging breach of contract to be misappropriating, misrepresenting, falsely labeling, or using the property in "other and deceitful ways" (slip opn, p 4, n*), but a contract action does not without more become a tort action. In the cases cited by the majority for the proposition that the use of property in "other and deceitful ways" may give rise to a tort action — *North Shore Bottling, Rich, Fantis Foods and Albe-marle Theatre* (slip opn, pp 4-5, n*) — there was not, as here, a fundamental dispute regarding the terms of the contract, which would itself be wholly determinative of the "tort" issue.

Characterization of the alleged breach of contract as a tort does not breathe vitality into a contract otherwise unenforceable for want of a writing. (See, e.g., *Intercontinental Planning v Daystrom, Inc.*, 30 AD2d 519, *affd* 24 NY2d 372.) Not one of the misappropriation cases cited by the majority involves an acknowledged contract between the parties permitting defendant in the first instance to use plaintiff's property, and a mere dispute as to the reach of the contract.

We have only recently reaffirmed the principle with respect to the Statute of Limitations that where an action is fundamentally contractual, plaintiff cannot rely on incidental allegations of fraud to keep its lawsuit viable. (*Queensbury Union Free Sch. Dist. v Jim Walter Corp.*, 101 AD2d 992, 993, *affd* 64 NY2d 964 [decided March 21, 1985].) By the same token, plaintiff should not be permitted to avoid the Statute of Frauds by enforcing an oral contract as a tort action for "false labeling."

I would therefore affirm the Appellate Division order in its entirety.

Patent and Trademark Office Board of Patent Appeals and Interferences

Ex parte Obiaya

Opinion dated July 23, 1985

PATENTS

1. Patentability — Invention — In general (§51.501)

Inventor's recognition of another advantage that would flow naturally from following suggestion of prior art cannot be basis of patent-

ability when differences would otherwise be obvious.

2. Double patenting — In general (§33.1)

Reissue — In general (§58.1)

Double patenting rejections are analogous to Section 103 rejections and depend on presence of prior "patent" as basis for rejection, and thus such rejection falls within ambit of those intended by reexamination statute.

Particular Patents — Combustible Element

4,128,458, Obiaya, Combustible Element and Oxygen Concentration Sensor, Claims 1-13, rejected.

Appeal from Art Unit 112.

Reexamination No. 90/000,449, for No. 4,128,458, issued Dec. 5, 1978, based on application, Serial No. 845,049, filed Oct. 25, 1977. Rejection of Claims 1-13, sustained.

Stephen J. Schultz, for appellant.

Before Merker, Katz, and Pellman, Examiners-in-Chief.

Katz, Examiner-in-Chief.

This is a reexamination of Patent No. 4,128,458 and was requested by the defendant in an infringement suit brought by patentee.

This is an appeal from the final rejection of claims 1 through 14, which are all the claims in the case.

Claims 1 and 6 are illustrative of the appealed claims and read as follows:

1. A combustible fluid and oxygen concentration sensor comprising:

- a. a combustible concentration analyzer;
- b. an oxygen concentration analyzer;
- c. conduit means for routing a fluid sample past said combustible concentration analyzer and oxygen concentration analyzer;
- d. an inlet port to said conduit means for receiving a sample fluid;
- e. an outlet port from said conduit means for ejecting said sample after analysis;
- f. means for producing fluid flow in said conduit means from said inlet port to said outlet port;
- g. means to correct the combustible concentration analyzer to an indicator; and
- h. means to connect the oxygen analyzer to a second indicator;
- i. said conduit means comprising:

- i. first and second portions arranged to divide the flow into separate paths downstream from said inlet and upstream from said flow producing means;
 - ii. said first portion supplying the oxygen analyzer but not the combustible analyzer [sic, analyzer] with sample fluid;
 - iii. said second portion supplying the combustible analyzer but not the oxygen analyzer with sample fluid;
 - iv. a heater associated with said second portion upstream of said combustible analyzer; and
 - v. an inlet for providing air to said second portion upstream of said heater, to insure complete combustible analysis within said combustible analyzer.
6. The combustible fluid and oxygen concentration analyzer of Claim 4 where said oxygen concentration analyzer comprises:
- a. a reactor member;
 - b. a heater element, configured in the form of a mesh structure, embedded within said reactor member; and
 - c. a base for mounting said reactor member;
 - d. said reactor member comprising:
 - i. an electrolyte with oxygen ion vacancies providing paths for oxygen ion conduction;
 - ii. a first and second conductive electrode for inducing a voltaic reaction within said source, and
 - iii. means for connecting said first and second conductive electrodes to external means for measuring the voltage difference created in said electrodes by said voltaic reaction.

The claimed invention relates to a sensor containing a combustion fluid and oxygen concentration analyzer in which a fluid sample is drawn into the sensor apparatus and separated into two parts, one part going to the oxygen analyzer and the other part going to the combustion analyzer. A heater is employed to maintain the sample going to the combustion analyzer at a constant temperature to obtain uniform results. An inlet is also provided such that air can be used to combust the materials going to the combustion analyzer. The components of the oxygen analyzer are set out in greater detail in claims 6 and 13.

The references relied on are:

Lamb et al.	1,321,063	Nov. 4, 1919
Yant et al.	2,531,592	Nov. 28, 1950
Cherry	2,743,167	Apr. 24, 1956
Ross et al.	3,960,500	June 1, 1976
Fisher	4,063,898	Dec. 20, 1977
Obiaya	4,129,491	Dec. 12, 1978

"Product Specification E65-1, Oxygen and Combustibles Analyzer," 1956

"Bailey Product Instructions E65-6, Gas Analyzers Type OA, OB and OC", 1965

"Product Instructions E65-15, Heat Prover Combustion Analyzer", 1956

Bulletin P-23 of Thermox Instruments, Inc., 1976

Claims 1, 2, and 7 stand rejected under 35 U.S.C. 103 in view of the combination of OC Analyzer, Heat Prover or E65-1 in view of Ross et al. Claims 3, 4, 8 through 11 and 14 stand rejected for the same reasons and further in view of Yant et al., Lamb et al. or Cherry. Claim 7 stands rejected for the same reasons and further in view of Thermox. Claims 8 and 11 stand rejected under 35 U.S.C. § 103 in view of the combination of OC Analyzer, Heat Power or E65-1 taken with Ross et al., Thermox and Yant et al., Lamb et al. or Cherry. Claims 5 and 12 stand rejected under 35 U.S.C. § 103 over OC Analyzer, Heat Prover or E65-1 taken with Ross et al. and either Yant et al., Lamb et al. or Cherry and further in view of Fisher. Claims 6 and 13 stand rejected under the judicially-created doctrine of obvious type double patenting in view of the combination of the patented subject matter of claims 1 through 3, 6 and 7 of Obiaya taken with OC Analyzer, Heat Prover or E65-1 with Ross et al. and also either Yant et al., Lamb et al. or Cherry.

We have carefully considered the arguments in this case and find that we agree with the examiner for the reasons set forth in the Answer. We adopt these reasons as our own and add the following only for purpose of emphasis.

In view of the fact that the examiner has answered each of the points made by appellant, it would be redundant to repeat these points. We will restrict our comments to the highlights of the appeal.

The main features of the claimed invention relate to the parallel flow of a divided sample to two different analyzers, a vacuum to draw the sample to the analyzers and then to exhaust, and a heater means upstream of a combustion analyzer. A number of the claims call for specific features, such as a labyrinth heater, a pressure regulator and the use of a specific combustion sensor.

We believe that the references clearly disclose each of the features in similar apparatus such that one skilled in this art having these references available would have found the claimed invention to be obvious. The examiner has established a *prima facie* case of obviousness. See *In re Lintner*, 458 F.2d 1013, 173

USPQ 560 (CCPA 1972) and *In Re Greenfield*, 571 F.2d 1185, 197 USPQ 227 (CCPA 1978). A number of the references, exemplified by E65-1, disclose that it is well-known to divide a sample into separate parts and pass one part to an oxygen sensor and the other part to a combustion sensor, the parts then being recombined and exhausted. Ross et al. disclose that the art recognizes that samples may be aspirated or sucked into the system so as to pass through the sensor. A number of the references disclose labyrinth heaters, pressure regulators and, as set forth in the claims of the Obiaya patent, combustion analyzers of the type described in claims 6 and 13, now before us.

Appellant has pointed out the deficiencies in each of the references. However, the rejection is based on the combination of references. The test of obviousness under 35 U.S.C. § 103 is not the express suggestion of the claimed invention in any or all of the references, but what the references taken collectively would suggest to those of ordinary skill in the art presumed to be familiar with them. Note *In Re Rosselet*, 347 F.2d 847, 146 USPQ 183 (CCPA 1965) and *In Re Simon*, 461 F.2d 1387, 174 USPQ 114 (CCPA 1972). We believe that one skilled in this art would have understood that the various features of the references could be combined to obtain the expected additive results.

[1] Appellant has presented evidence to indicate that a shorter response time is obtained when a labyrinth heater is employed, this being an unexpected result. However, the references disclosing labyrinth heaters indicate that the advantage obtained by using such heaters is that samples are maintained at a uniform temperature. The fact that appellant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. Note *In Re Best*, 562 F.2d 1252, 195 USPQ 430 (CCPA 1977) and *In Re Wilder*, 429 F.2d 447, 166 USPQ 545 (CCPA 1970).

The examiner has rejected claims 6 and 13 on the judicially-created doctrine of double patenting of the obviousness type. The determination of whether the rejection is proper under the reexamination statute is a question of first impression. The Statute governing reexamination of patents is contained in 35 U.S.C. § 301-307.

35 U.S.C. § 301 contains the key language that:

"Any person at any time may cite to the Office in writing *prior art* consisting of *patents or printed publications*." (emphasis added).

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Section 302 states that a request for reexamination by the Office of any claim of a patent may be:

"on the basis of any *prior art* cited under the provisions of Section 301." (emphasis added).

However, Section 303(a) states that the Commissioner, on his own initiative, may initiate a reexamination procedure.¹ He may determine whether a substantial new question of patentability has been raised by the request with or without consideration of *other patents* or printed publications, as well as those cited pursuant to Section 301. We note that the words "prior art," used in Sections 301 and 302, do not appear in this Section.

The Statute refers to both patents and printed publications. Patents are printed as publications by most countries,² and if they are to be used only in such capacity then there would have been no reason for this redundancy. We must assume that Congress intended patents to also be the basis for rejection other than as a printed publication. Thus, patents may be used as evidence of prior inventorship by another or as evidence that the patentee of the reexamination patent has already obtained patent protection for his invention. The second patent would be barred by Section 101 if the inventions are identical or by the judicially-created doctrine of double patenting of the obviousness type, if there are only obvious differences between the claims of the respective patents.

However, Section 301 contains the limitation "prior art" to describe the patents and printed publications. Normally, "prior art" rejections exclude those based on public use or sale and those based on Section 112.³

[2] Where do "double patenting rejections of the obviousness type" fit in? Are they permissible under the reexamination statute, or are they, like public use and sale rejections, and Section 112 rejections (except as to new and amended claims), excluded? *In re Etter*, *supra*, states (225 USPQ p. 4):

"Patent claims are reexamined only in light of patents and printed publications under 35 U.S.C. §§102, 103 . . ."

Double patenting rejections are analogous to Section 103 rejections and depend on the pres-

ence of a prior "patent" as the basis for the rejection. Thus, we take the position that such rejection falls within the ambit of those intended by the statute and are not specifically excluded by the *Etter* case. Further, the *Etter* court focused on the question of presumption of validity with regard to a reexamination patent and its statement as to the scope of proper rejections in the evaluation of a reexamination patent are not the point of the ruling.

We now deal with the *merits* of the double patenting rejection. The rejection is based on the evidence that the general combination of oxygen and combustion analyzers used with sampling devices is known and that it would have been obvious to employ the particular oxygen analyzer defined in the claims of the Obiaya patent in combination with the sampling device. We believe that claims to such combination do not define a separate and distinct invention from the claims to the oxygen analyzer.

Appellant has indicated that it would be futile to add a terminal disclaimer to this reexamination application since this application has a patent date which is earlier than that of the other Obiaya patent. It appears that appellant's choice is clear. He may acquiesce in the double patenting rejection or he may file a terminal disclaimer in his other patent, assuming that the Obiaya patent and the present application are commonly owned.

The decision of the examiner is affirmed.

AFFIRMED.

District Court, N. D. Iowa

United States Jaycees v.
Cedar Rapids Jaycees

No. C 82-176

Decided August 1, 1985

TRADEMARKS

1. Title — Licenses (§67.867)

Injunctive relief is not warranted in United States Jaycees' action to terminate licensee's use of trademark "Jaycees" solely because licensee admitted women as members, since government's interest in preventing invidious discrimination outweighs public interest in preventing trademark infringement and in preventing market confusion.

¹ *Houston Atlas, Inc. v. Del Mar Scientific Inc.*, 217 USPQ 1032 at 1037 (DC N.Tex. 1982).

² Manual of Patent Examining Procedure, 4th Ed., Aug. 1983, page 900-5, Section 901.05D(b), Unprinted Foreign Patents.

³ *In re Etter*, 756 F.2d 852, 225 USPQ 1 (Fed. Cir. 1985) (at 4) states that "...only new or amended claims are also examined under 35 U.S.C. §§112 and 132, 37 CFR 1.552; MPEP §2258."